

REMARKS

Applicants amended the Abstract to correct a typographical error. Support for the amendment is found in the Specification, considered as a whole, e.g., in the Abstract of WO 2004/018001. Applicants also amended several claims to improve their form. Applicants respectfully point out that the claims were amended in the International Application under Article 19. Claims 1-7 are currently pending in this application, and are subject to a restriction requirement.

Restriction Requirement

The Examiner required that Applicants select for prosecution one of the following groups of claims:

Group I, claims 1-7 drawn to compounds, compounds and methods wherein variables as R^1 , R^3 , R^4 , R^5 , or R^6 as defined in claim 1 and the polyamine is chosen from section A or D of claim 1.

Group II, claims 1-7, drawn to compounds, compounds and methods wherein variables as R^1 , R^3 , R^4 , R^5 , or R^6 as defined in claim 1 and the polyamine is chosen from section B of claim 1.

Group III, claims 1-7, drawn to compounds, compounds and methods wherein variables as R^1 , R^3 , R^4 , R^5 , or R^6 as defined in claim 1 and the polyamine is chosen from section C of claim 1.

Group IV, claims 1-7 drawn to compounds and compositions, wherein variable R is defined as R^2 as defined in claim 1 and the polyamine is chosen from section A or D of claim 1^A.

^A While the Office Action referred to claims 1-5, 11 in Groups IV-VI, the Examiner confirmed in a phone interview, summarized below, that claims 1-7 were intended.

Group V, claims 1-7, drawn to compounds and compositions, wherein variable R is defined as R² as defined in claim 1 and the polyamine is chosen from section B of claim 1.

Group VI, claims 1-7, drawn to compounds and compositions, wherein variable R is defined as R² as defined in claim 1 and the polyamine is chosen from section C of claim 1.

Office Action, pages 1-2.

The Examiner also requested that Applicants elect a single disclosed species for prosecution on the merits, from the patentably distinct species of Groups I-VI. Office Action, page 5.

In support of the restriction requirement, it was stated that:

Inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because under PCR Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

(f) Markush practice ‘The situation involving the so-called Markush practice wherein a single claim defines alternatives (chemical or non-chemical) is also governed by PCT Rule 13.2. In this special situation, the requirement of a technical interrelationship and the same or corresponding special technical features as defined in PCT Rule 13.2, shall be considered to be met when the alternatives are of a similar nature.

(i) When the Markush grouping is for alternatives of chemical compounds, they shall be regarded as being of a similar nature where the following criteria are fulfilled:

(A) All alternatives have a common property or activity; and

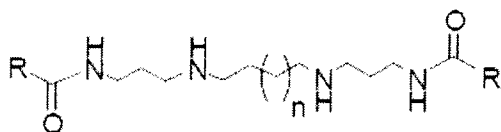
(B) (1) A common structure is present, i.e., a significant structural element is shared by all of the alternatives; or

(B) (2) In cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

In paragraph (f) (i) (B) (1), above, the words “significant structural element is shared by all of the alternatives” refer to cases where the compounds share a common chemical structure which occupies a large portion of their structures, or in case the compounds have in common only a small portion of their structures, the commonly shared structure constitutes a structurally distinctive portion in view of existing prior art, and the common structure is essential to the common property or activity. The different groups for variable R and the polyamine result in compounds that have achieved a different status in the art, and thus are drawn to an improper Markush group on the grounds of lack of a common nucleus. Thus a lack of unity is apparent.”

Office Action, pages 2-3. It was asserted that a preliminary search of a selected core gave numerous iterations, which were set forth at page 4 of the Office Action.

Applicants respectfully disagree and traverse this Restriction Requirement. However, in order to be fully responsive to the Restriction Requirement, Applicants provisionally elect, with traverse, the subject matter of Group I for prosecution on the merits, represented by claims 1 -7 compounds, compounds and methods, where variables as R^1 , R^3 , R^4 , R^5 , or R^6 as defined in claim 1 and the polyamine is selected from section A or D of claim 1. Applicants further elect, with traverse, the first species of claim 1. a), i.e.



where $R=R^1$ and $n=1$

Applicants respectfully submit that the claims relate to a single general inventive concept, and therefore do not lack unity of invention. According to the M.P.E.P. § 1850, when the Office considers international applications as an International Searching Authority, as an International Preliminary Examining Authority, and during the national stage as a Designated or Elected

Office under 35 U.S.C. § 371, PCT Rule 13.1 and 13.2 will be followed when considering unity of invention of claims of different categories without regard to the practice in national applications filed under 35 U.S.C. § 111. The M.P.E.P. also explicitly states that the decision with respect to unity of invention rests with the International Searching Authority or the International Preliminary Examining Authority. *Id.*

Applicants respectfully point out that there was no unity of invention objection issued during the international phase of the application. *See* International Preliminary Examination Report, dated December 15, 2004, copy enclosed for the Examiner's convenience. Thus, since neither the International Searching Authority nor the International Preliminary Examining Authority decided there was a lack of unity of invention, it is improper for the U.S.P.T.O. to hold otherwise. For at least this reason, the restriction and election of species requirements are improper and must be withdrawn.

Please also see, *Caterpillar v. Commissioner of Patents & Trademarks*, 231 USPQ 590 (DC, E.D. VA 1986) wherein the court held that a U.S. national stage of a PCT application containing claims directed to a process and apparatus for its practice must be examined in the same application since they satisfy the requirement of unity of invention of the PCT rules. The same principle should apply to claims directed to compounds and to a process for manufacturing the compounds, present in this application. Support for Applicant's position is found, *inter alia*, in the Patent Cooperation Treaty, in particular the PCT International Search and Examination Guidelines, Chapter 10, Section 10.12.

The USPTO rules are consistent with the above principles. Thus, 37 C.F.R. § 1.475 states, in pertinent part:

“(b) ...a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

(1) A product and a process specially adapted for the manufacture of said product, or...

(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product...”

As discussed above, Applicants’ claims are directed at least to a product and a process for making thereof.

It was stated that each of different inventions requires different structural inquiries and can be classified differently. For example, it was asserted that because polyamines of sections (a) and (d) of claim 1 are both linear polyamines, they would require different structural queries when the polyamine is chosen from sections (b) or (c). It was asserted that section (b) polyamines can be classified depending upon which linker is selected (if the chain includes a furan ring, it can be classified in class 549, subclass 439, and it would be mutually exclusive of the polyamine linkers of sections (a) (c) and (d)). Section (c) polyamines are assertedly classifiable in class 540, subclass 450, and polyamines of sections (a) and (d) in class 564, subclass 123.

Office Action, page 5.

The Examiner asserted that different polyamines of various sections of claim 1 “can be classified” in different classes and subclasses, as summarized above. However, different classification of claims is not necessarily an indication of the distinctiveness of various groups from each other. Art relevant to polyamines of sections (a) and (d), may be found in the class and subclass artificially assigned to sections (b) and (c). Likewise, art relevant to polyamines of section (b) may be found in classes and subclasses assigned to sections (a), (c) and (d), and *vice versa*. As stated in the M.P.E.P. § 803 “If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.” Applicants respectfully submit that no undue burden will be placed on the USPTO in examining all the currently pending claims in the same application.

Furthermore, in the Office Action, the Examiner issued a restriction requirement directed to a single claim, which is improper as a matter of law, as discussed in detail below.

Applicants note that claims 1-7 have been placed in all Groups I-VI and that in most, if not all, Groups “independent” inventions were identified within individual claims, e.g., claim 1 was asserted to have seven separate inventions (R¹, R³, R⁴, R⁵, or R⁶, A or D).

The courts have long held that an Examiner may not reject a particular claim on the basis that it represents “independent and distinct” inventions. *See, In re Weber, et al.* 198 USPQ 328, 331 (C.C.P.A. 1978). *See also, In re Haas* 179 USPQ 623, 624, 625 (C.C.P.A. 1973) (In re Haas I) and *In re Haas* 198 USPQ 334-337 (C.C.P.A. 1978) (In re Haas II).

The courts have consistently ruled that the section of the patent statute authorizing restriction practice, i.e., 35 U.S.C. §121, provides no legal authority to impose a restriction requirement on a single claim, even if the claim presents multiple independently patentable inventions. *See, In re Weber et al., In Re Haas I* and *In Re Haas II*. In the cases set forth above, the courts expressly ruled that there is no statutory basis for rejecting a claim for misjoinder, despite previous attempts by the Patent Office to fashion such a rejection. As noted in *In re Weber et al.*:

The discretionary power to limit one applicant to one invention is no excuse at all for refusing to examine a broad generic claim--no matter how broad, which means no matter how many independently patentable inventions may fall within it.

See *In re Weber, et al.* at 334.

Applicants note the Examiner’s assertion that, if the Markush grouping is for the alternatives of chemical compounds they will be regarded as being of a similar nature, where the criteria set forth above are fulfilled i.e.,

“A. all alternatives have a common property or activity; and

(B) (1) A common structure is present, i.e., a significant structural element is shared by all of the alternatives; or

(B) (2) In cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical

compounds in the art to which the invention pertains.”

Office Action, page 3.

According to the MPEP Section 803.02, dealing with restriction requirements of Markush claims, “If the members of the Markush group are...so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits”, even if they may be directed to distinct and independent inventions. *See* page 800-5 (Emphasis supplied).

In view of the above remarks, Applicants respectfully request that the restriction requirement and the election of species requirement be withdrawn and that all claims be prosecuted in this application. In the event that the requirement is made final, and in order to comply with 37 CFR §1.143, Applicants reiterate their provisional election of Group I and the first species of claim 1 (a) as set forth above. Applicants hold the remaining claims in abeyance under the provisions of 37 C.F.R. § 1.142(b) until final disposition of the elected claims.

SUBSTANCE OF TELEPHONE INTERVIEW

Applicants express their appreciation to the Examiner for granting them on August 1, 2007, a telephone interview. Applicants’ undersigned Counsel sought clarification regarding the inclusion in Groups IV-VI of claim 11, since the Application includes only seven claims (claims 1-7). The Examiner advised that the reference to claim 11 was an inadvertent error and that each of Groups IV-VI was intended to include claims 1-7.


The Examiner also advised that, regarding the election of species, Applicants can elect anyone of the species disclosed in the application or defined in the claims. For example, according to the Examiner, if Applicants elect Group I, they can elect any of the species in claim 1, sections (a) or (d) or any other species from the specification covered by sections (a) or (d) of claim 1.

CONCLUSION

For all the reasons detailed above all claims in the Application are in condition of allowance, an indication of which is respectfully solicited. In the event any outstanding issues remain, Applicants would appreciate a telephone call to the undersigned Counsel to resolve such issues in an expeditious and effective manner to place the application in condition for allowance.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 502478 and please credit any excess fees to such deposit account.

Respectfully submitted,


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